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OFFICE OF PETITIONS

BARNES & THORNBURG LLP
11 SOUTH MERIDIAN
INDIANAPOLIS IN 46204

In re Application of	:	
Vlahov et al.	:	ON APPLICATION FOR
Application No. 10/765,336	:	PATENT TERM ADJUSTMENT
Filed: January 27, 2004	:	
Attorney Docket No.20150-74359	:	
	:	

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT RECONSIDERATION UNDER 37 C.F.R. § 1.705(B) filed June 26, 2009. Applicants submit that the correct patent term adjustment to be indicated on the patent is one thousand fifty-five (1,055) days, not four hundred seventy-eight (478) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the 37 CFR 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant at (571) 272-3215.

Kery A. Fries

Kery Fries
Senior Legal Advisor Attorney
Office of Patent Legal Administration

Date Calculator Result

From 01/27/2007 to 08/26/2008 is 577 days.

New calculation

BARNES & THORNBURG LLP

11 South Meridian Street
Indianapolis, Indiana 46204
(317) 236-1313
(317) 231-7433 Fax

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Customer No.: 23643

Group: 1618

Confirmation No.: 9879

Application No.: 10/765,336

Patent No.: Unknown

Invention: VITAMIN RECEPTOR BINDING
DRUG DELIVERY CONJUGATES

Inventor: Iontcho R. Vlahov

Filed: January 27, 2004

Attorney Docket: 20150-74359

Examiner: Dameron Levest Jones

FILED ELECTRONICALLY:
June 26, 2009

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT **UNDER 37 C.F.R. §1.705(d)**

Mail Stop Patent Extension
Director for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

It is respectfully requested that the Office reconsider the Patent Term Adjustment determined in the above-identified U.S. Application Serial No. 10/765,336, and revise the Patent Term Adjustment to **1055 days**, which is believed to be the correctly calculated Patent Term Adjustment.

U.S. Appl. No. 10/765,336
Request for PTA Reconsideration

The revised Patent Term Adjustment was determined according to the grounds for adjustment under 37 C.F.R. § 1.702(a) and 37 C.F.R. § 1.702(b) and was calculated according to the periods of adjustment under 37 C.F.R. § 1.703(a) and 37 C.F.R. § 1.703(b). Furthermore, the revised Patent Term Adjustment is established according to the recent decision by the U.S. Court for the District of Columbia in *Wyeth v. Dudas*, 580 F.Supp.2d 138, 88 U.S.P.Q.2d 1538 (D.D.C. 2008). A summary of the revised Patent Term Adjustment is below.

	Relevant Dates	Period of Adjustment
Examination Delay under 37 C.F.R. § 1.702(a)	37 C.F.R. § 1.703(a)(1) Filing date of patent application: <u>January 27, 2004</u> Fourteen months after filing date of patent application: <u>March 27, 2005</u> First Action mailed by USPTO: <u>January 17, 2007</u>	Difference for which patentee should receive credit: <u>+ 661 days</u> ,
Examination Delay under 37 C.F.R. § 1.702(b)	37 C.F.R. § 1.703(b) Filing date of patent application: <u>January 27, 2004</u> Three years after filing date of patent application: <u>January 27, 2007</u> Date of filing an RCE by Applicant: <u>August 26, 2008</u>	Difference for which patentee should receive credit: <u>+ 577 days</u> ,
Circumstances under 37 C.F.R. § 1.704(b)	37 C.F.R. § 1.704(b) Request for a three-month Extension of Time Office Action mailed by USPTO: <u>June 29, 2007</u> Three-month due date: <u>September 29, 2007</u> Response received by USPTO: <u>December 13, 2007</u>	Difference for which §1.702 period of adjustment should be reduced: <u>-75 days</u>

U.S. Appl. No. 10/765,336
Request for PTA Reconsideration

	Relevant Dates	Period of Adjustment
Circumstances under 37 C.F.R. § 1.704(b)	<p>37 C.F.R. § 1.704(b)</p> <p>Request for a two-month Extension of Time</p> <p>Office Action mailed by USPTO: <u>March 26, 2008</u></p> <p>Three-month due date: <u>June 26, 2008</u></p> <p>Response received by USPTO: <u>August 26, 2008</u></p>	Difference for which §1.702 period of adjustment should be reduced: <u>-61 days</u>
Circumstances under 37 C.F.R. § 1.704(b)	<p>37 C.F.R. § 1.704(b)</p> <p>Request for a two-month Extension of Time</p> <p>Office Action mailed by USPTO: <u>October 29, 2008</u></p> <p>Three-month due date: <u>January 29, 2009</u></p> <p>Response received by USPTO: <u>March 17, 2009</u></p>	Difference for which §1.702 period of adjustment should be reduced: <u>-47 days</u>
Total PTA as of Date of Filing an RCE by Applicant		<u>1055 days</u>

Pursuant to the decision rendered in *Wyeth v. Dudas*, a patentee is entitled to Patent Term Adjustment credit for examination delay under 37 C.F.R. § 1.702(a) in addition to any examination delay under 37 C.F.R. § 1.702(b), to the extent that the two periods of delay do not "occur on the same calendar day or days." *Wyeth*, 580 F.Supp.2d at 140, 88 U.S.P.Q.2d at 1540. A copy of *Wyeth* is attached hereto as "Attachment A" for the Office's convenience.

Accordingly, the patentee of the above-identified patent application is entitled to a credit for the sum of 661 days under 37 C.F.R. § 1.702(a) and 577 days under 37 C.F.R. § 1.702(b), for a total of 1238 days, subject to a reduction of 183 days under 37 C.F.R. § 1.704. Thus, Applicants respectfully submit the total Patent Term Adjustment is 1055 days.

U.S. Appl. No. 10/765,336
Request for PTA Reconsideration

The above-identified patent is not subject to a terminal disclaimer. This Request is timely filed under 37 C.F.R. § 1.705(b) as it is being filed no later than the payment of the issue fee submitted herewith. Applicants respectfully request that, if any additional days accrue due to Patent Office delays pursuant to 37 C.F.R. § 1.702(a), the additional days be added to the total Patent Term Adjustment credit.

Applicants respectfully request revision of the Patent Term Adjustment as set forth above. The Director is hereby authorized to charge the Barnes and Thornburg LLP Deposit Account No. 10-0435 the amount of \$200.00 in payment of the reconsideration fee under 37 C.F.R. § 1.18(e), with reference to our Matter No. 20150-74359. The Director is also hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 10-0435, with reference to our Matter No. 20150-74359.

Respectfully submitted,



Bassam S. Nader
Reg. No. 61816
Agent for Applicants

BSN/jrt
Indianapolis, Indiana 46204
317-231-6415